

REMARKS

I. Introduction

Claims 33 to 65 are now pending in the present application. Claims 33 and 59 have been amended. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are in allowable condition.

II. Rejection of Claims 33, 55, and 57-58 under 35 U.S.C. § 102(b)

Claims 33, 55, and 57-58 have been rejected under 102(b) as being anticipated by EP 0 726 508 (Frampton; hereinafter referred as the “EP reference”). Claim 33 has been amended. Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added).

Amended claim 33 recites, in relevant parts: “allocating to the communication terminals at least a first operating mode and a second operating mode, the first operating mode defining an active phase, each one of the communication terminals placed in the active phase monitoring each announcement on the announcement channel, and the second operating mode defining a sleep phase in which the announcement channel is monitored only at intervals; causing the master station to send **synchronization information including at least one frame symbol** in order to synchronize the communication terminals; **causing the communication terminals to analyze the synchronization information** including the at least one frame symbol at least in intervals **in the first operating mode**, the synchronization information correcting respective time bases of the communication terminals; and **causing the communication terminals to analyze the synchronization information in at least the second operating mode**.” (emphasis added)

In support of the rejection, the examiner cites column 2, line 43 to column 5, line 51 of the EP reference. The EP reference discloses two modes of operation, an active first mode and a standby mode, as described in column 2, line 56 to column 3, line 8. However, the EP reference does not disclose that in its standby mode (i.e., a non-active mode) synchronization information is analyzed by the terminals. Thus, the EP reference does not disclose the claimed features recited above, and therefore, does not disclose all the features in claim 33. Rather, the EP reference only describes that in sleep condition the terminal operates with a lower frequency sleep clock. This lower frequency sleep clock is not synchronized with synchronization information of the master station because in sleep mode there is no analyzing of synchronization information of the master station at all. For at least this reason, the EP reference fails to anticipate amended claim 33. Claims 55 and 57 - 58, which depend on amended claim 33, are similarly not anticipated by the EP reference.

III. Rejection of Claims 34-35 and 50-51 under 35 U.S.C. § 103(a)

Claims 34-35 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference and U.S. Patent No. 6,356,538 (“Li”).

Claims 34-35 and 50-51 depend on amended claim 33. Furthermore, Li does not cure the deficiencies of the EP reference as applied against parent claim 33. Therefore, claims 34-35 and 50-51 are similarly not unpatentable in view of the EP reference.

IV. Rejection of Claims 36-43, 45, 48-49, 56 and 59-65 under 35 U.S.C. § 103(a)

Claims 36-43, 45, 48-49, 56 and 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference and Li, and further in view of U.S. Patent No. 6,879,579 (“Myles”).

Initially, Applicants note that this rejection is invalid since Myles is not an effective prior art against the present invention. Myles issued on April 12, 2005, and Myles has 102(e) date of May 30, 2000, which is after the priority date of the present invention, November 13, 1998. Furthermore, the PCT application corresponding to Myles was published on April 1, 1999, which is after the priority date of the present invention and less than 1 year before the effective U.S. filing date of the present invention, September 10, 1999.

In any case, claims 36-43, 45, 48-49, 56 and 64-65 ultimately depend on claim 33. In addition, Myles and Li do not cure the deficiencies of the EP reference as applied against parent claim 33. Therefore, claims 36-43, 45, 48-49, 56 and 64-65 are not unpatentable in view of the EP reference, Li and Myles.

Regarding the rejection of claims 59-63, Applicants note that claim 59 has been amended to recite in relevant parts: “a decision circuit by which a synchronization of the terminal can be controlled with respect to synchronization information including frame symbols received from a master station, the decision circuit assuming a control of the terminal from an actual controller of the terminal when the terminal goes from an **active first operating mode into another operating mode corresponding to one of a second operating mode including a standby mode and a third operating mode including a sleep mode, wherein the terminal analyzes synchronization information during at least one of the second and third operating modes.**” (Emphasis added).

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The examiner contends that the EP reference discloses two modes, that Li discloses a third mode, and that Myles discloses communication between the master station and terminals. However, the EP reference, Li, and Myles do not disclose the claimed features recited above, i.e., the terminal analyzes synchronization information during a second operating mode or a third operating mode. Applicants note that in order for a claim to be rejected under 35 U.S.C. § 103(a), not only must the cited references teach or suggest each element of the claim, but the prior art must also *suggest the desirability* of combining the elements in the manner contemplated by the claim. M.P.E.P. § 2143.01 (citing In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As disclosed in the EP reference, only during active operation is there a calibration with reference to the system clock. Otherwise, there are no synchronization operations disclosed. As stated before, the prior art references must teach or suggest all of the claim limitations. The EP reference, Li, and Myles fail to disclose synchronization in other modes, e.g., during a second or third mode. For at least this reason, the applied references fail to render obvious amended claim 59 and its dependent claims 60-63.

V. Rejection of Claims 46-47 under 35 U.S.C. § 103(a)

Claims 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference in view of U.S. Patent No. 5,606,313 (“Allen”).

Applicants note that claims 46-47 ultimately depend on claim 33. In addition, Allen fails to cure the deficiencies of the EP reference as applied against parent claim 33. Accordingly, the combination of the EP reference and Allen fails to render obvious claims 46-47.

VI. Rejection of Claims 52-54 under 35 U.S.C. § 103(a)

Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference in view of U.S. Patent No. 5,794,137 (“Harte”).

Applicants note that claims 52-54 ultimately depend on claim 33. In addition, Harte fails to cure the deficiencies of the EP reference as applied against parent claim 33. Accordingly, the combination of the EP reference and Harte fails to render obvious claims 46-47.

VII. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON



(R. No. 36,197)

Dated: 12/2, 2005

By: JONG LEE for Gerard Messina
Gerard A. Messina
Reg. No. 35,952
One Broadway
New York, NY 10004
(212) 425-7200

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